

No. 12,160

IN THE
United States Court of Appeals
For the Ninth Circuit

RALPH D. GOMEZ and WILLIAM HENDER-
SON, as individuals and co-partners
doing business under the name of
Gomez Manufacturing Company,

Appellants,

vs.

GRANAT BROS., a corporation, and JOSEPH
GRANAT,

Appellees.

Appeal from the United States District Court for the
Northern District of California, Southern Division.

BRIEF FOR APPELLANTS.

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BRIEF FOR APPELLANTS.

STATEMENT OF THE CASE.

This action was originally commenced by plaintiffs-appellants under Sec. 274d of the Judicial Code, 28 U. S. C. A. § 400 for a declaratory judgment establishing the invalidity of the Granat Patent No. 2,059,228. The complaint alleged that the patent in

(NOTE): All italics supplied unless otherwise specified.

suit was invalid; that threatening letters charging infringement sent by defendants-appellees to customers of plaintiffs-appellants had resulted in considerable loss of business; and that if the threats of suit were allowed to continue irreparable damage would result to plaintiffs-appellants and to their customers. A cross-complaint charging infringement of the aforesaid patent in suit was subsequently filed in this action. Prior to the trial a written stipulation (R. p. 25) was duly filed wherein it was agreed that an actual controversy existed. The court below dismissed the complaint, found that the patent in suit was valid and infringed, and issued an injunction restraining plaintiffs-appellants from manufacturing and selling infringing finger ring ensembles.

The findings of fact and conclusions of law adopted by the court are found at pages 29 to 36 of the printed record. No briefs were presented after the trial and no opinion was filed by the court below, but the findings of fact and conclusions of law entered herein indicate that the court found with appellees on all of the allegations of the cross-complaint as well with respect to all of their contentions made at the trial.

Appellants in their *Statement of Points Relied Upon* (R. p. 47) challenge the correctness of Findings Nos. 4, 5, 8, 12, 13, 14, 15, 16, 17, 18, 21, 22 and 23 and Conclusions of Law Nos. 2, 3, 4, 5, 6, 7, 8, 9 and 10.

Briefly stated the errors to be corrected by the appeal are:

1. The dismissal of the complaint.
2. The entry of a decree in favor of appellees.
3. The granting of an injunction against appellants.
4. Sustaining the validity of the patent in suit.
5. Awarding damages to appellees in an amount equal to eight per cent (8%) of the retail sales price of the alleged infringing rings manufactured and sold by appellants.
6. Awarding costs and attorney's fees to appellees.

The main issue to be decided by this appeal is whether the patent in suit is valid.

THE PATENT IN SUIT.

The patent in suit relates to a mechanically locked finger ring ensemble comprising an engagement ring and a wedding ring together with interconnecting means embodying a recess in the side of one of the rings within which lug or projection on the side of the other ring detachably fits.

The four claims of the patent in suit are substantially of the same scope except that claim 3 includes a stop associated with the recess of one ring for preventing the lug of the other ring from being re-

moved from the said recess except in a direction toward the two rings.

The claims are as follows:

1. In a ring ensemble, the combination of an engagement ring and a wedding ring, said engagement ring having an undercut recess formed in one side thereof, said wedding ring having a lug formed on one side thereof, said lug having the same configuration as said recess, whereby when said lug is inserted in said recess said rings will be locked together against axial rotation with relation to each other.

2. In a device of the character described, the combination of an engagement ring having a mounting formed thereon, and a wedding ring having a mounting formed thereon, said engagement ring having a recess formed in the side of said mounting, said recess having its bottom opening formed toward the axis of said ring, said recess being further provided with dove-tailed ends, said wedding ring having a lug formed thereon, said lug having the same configuration as said recess and capable of entirely filling said recess when said rings are side by side and in axial alignment.

3. In a device of the character described, the combination of a wedding ring and an engagement ring, each of said rings having a mounting formed thereon, locking means interposed between said rings, said locking means including a recess formed in one of said rings, and a lug formed upon the other of said rings, said recess and said lug having the same area, the upper

end of said recess forming a stop for said lug, whereby said lug may be removed from said recess only in a direction toward the axis of said rings.

4. A jewelry set comprising, in combination, two rings, one of said rings having a mortise on the side thereof, said mortise being open at one end thereof and the second ring having a tenon on the side thereof which fits into said mortise for holding the two rings against relative displacement on the wearer's finger, said tenon being projected into said mortise by a relative movement of said rings in a plane substantially parallel to the sides of the rings.

It is to be noted that the mechanical means recited in claims 1, 2 and 3 for detachably securing the two finger rings of the ensemble together comprises an undercut recess on the side of one ring and a lug of the same configuration on a side of the other ring. In claim 4 this same connecting means is defined as a tenon on the side of one ring fitting in a mortise in the side of the other ring. A commonly used term for an undercut recess and an engaging lug of the same configuration is "a dovetail connection." A "mortise and tenon connection" in so far as this discussion is concerned comprises a similar combination.

A "dovetail connection or joint" is sufficiently well known to be defined in dictionaries. In *Webster's New International Dictionary* at page 777 the definition is given as follows:

“Dovetail joint—a flaring tenon or tongue and a mortise or socket into which it fits, making an interlocking joint between the pieces which resist pulling apart in all directions except one.”

It is to be noted that what the patentee Granat uses to connect his two rings together is a “dovetail” joint or connection.

APPELLANTS' RING ENSEMBLE

Appellants have been manufacturing ring ensembles of the type embodying a wedding ring and an unattached engagement ring since about 1938, but only since the early part of 1948 have they been making locked ring ensembles. (R. p. 124). Explaining how in 1948 he commenced the manufacture of a mechanically locked ring ensemble, Mr. Gomez testified (R. p. 129) that because of the trend in the jewelry business to have the wedding and the engagement rings locked together, he changed the construction of the two unattached rings of the ensemble he was then manufacturing (see sketch, defendants' exhibit H) by providing an indentation in the side of one ring and a projection in the side of the other ring (Defendants' exhibit I). Mr. Gomez testified positively that he had never seen the Granat Bros. ring ensemble having a mechanical locking feature. (R. p. 126, 139), until after he had commenced the manufacture and sale of his locked ring combination. Attention is directed to the foregoing, not because it tends to prove or disprove any of the

issues in this case, but because of the inference made at the trial that Mr. Gomez might have adopted the type of inter-connecting means embodied in appellants' ring ensemble after having seen that made and sold by Granat Bros. As a matter of fact appellees have manufactured several types of ring ensembles and have advertised them rather extensively but, as indicated in defendants' exhibit D, the advertisements show no particular type of connecting means for the illustrated rings nor do they have any patent numbers displayed in connection with the illustrations.

Admittedly, the ring ensemble manufactured by appellants comes within the scope of the patent in suit, but it is contended that all of said claims are invalid.

ARGUMENT.

THE PRIOR ART.

The art cited by the Patent Office was woefully meager, and practically all of the prior art which should have been considered during the prosecution of the patent application was overlooked. The only prior art citation was the Harris patent No. 2,000,228. (File History of Granat Patent in suit.)

The lower court's finding (Finding of Fact No. 17) that the prior art before the Patent Office was the most pertinent prior art on the subject of the patent in suit is in error.

It is to be noted that the Harris patent, while disclosing the combination of an engagement ring and a

wedding ring held in locked relationship, did not show the well-known dovetail tongue and groove connecting means of the patent in suit.

Other pertinent prior art not cited or considered during the prosecution of the patent application is as follows:

Kelly	152,233
Kaas	424,211
Bullard	464,749
Linderman	517,348
Grierson	959,854
Atkinson	942,047
Tschirgi	1,482,772
Thomas	1,536,540
Beaujard	1,712,417
Hubbard	1,715,293
Mittleburg	1,829,366
Birnbaum	1,877,750

It will be noted that Kaas, Bullard, Thomas and Beaujard disclose ring ensembles comprising two finger rings arranged in interlocked relationship, while the other patents listed above show dovetail tongue and groove or mortise and tenon connecting means to have been commonly used in various arts to secure two elements together. In fact the use of dovetail tongue and groove, or mortise and tenon connecting means is notoriously old and for centuries such a connecting means has been commonly used by mechanics, jewelers, cabinet makers, builders, carpenters, plumbers and various other artisans. (R. pp. 77, 78.)

As far back as 1890 it was old to attach two rings together to provide an interlocked ring ensemble (Kaas patent No. 424,211), and in 1891 the securing of two finger rings together by tenon and mortise means was patented (Bullard patent No. 464,749). In 1925 a mortise in the side of one ring and a tenon on the side of another ring were used to secure the two rings together (Thomas patent No. 1,536,540). It is therefore the contention of appellants that the Granat patent in suit is fully anticipated by the prior art and is therefore invalid. It is readily apparent that the patentee, Granat, merely took the interlocked ring combination shown in such patents as Kaas, Bullard and Thomas and substituted for the type of connection shown in said patents, the well-known dovetail tongue and groove or mortise and tenon connecting means commonly used in various arts and more particularly disclosed in Kelly, Tschirgi, Hubbard, Atkinson, Mittleburg and various other patents. It is to be noted that in Kaas, Bullard and Thomas the two rings of the ensemble are held against independent rotation and relative displacement by the connecting means which joins them together (R. p. 77). The connecting means of the patent in suit operates in the identical same manner.

THE PATENT IN SUIT IS NOT PRESUMED TO BE VALID.

Generally speaking, a patent is presumed to be valid when it is issued by the patent office. This presumption does not follow the issuance of a patent,

however, when pertinent prior art is not cited or considered by the patent office during the prosecution of the patent application.

In the present case it is to be noted that the patent office overlooked practically all of the pertinent prior art. The only prior art cited by the examiner was the Harris patent, which in view of the filing date of one month prior to that of Granat could have been readily eliminated as a reference. There were many patents overlooked such as Kaas, Bullard, Thomas and others disclosing interlocking finger ring ensembles, and entirely ignored was the extensive prior art showing the commonly used tenon and mortise or dovetail tongue and groove connection.

In the Ninth Circuit case of *Stoody Co. v. Mills Alloys*, 67 F. (2d) 807, 810 the law with respect to the presumption as to the validity of a patent when pertinent prior art is not considered during the prosecution of the application, is given as follows:

“We do not agree with the contention, the fact that the file wrapper disclosed the patent to have been granted as first applied for without any references, adds any force to the presumption of validity arising from the grant. On the contrary we think the force of that presumption is much diminished, if not destroyed, by the lack of any reference by the examiner to the Clark patents. It does not seem likely that the expert examiner would pass them by without notice or consideration if they had been called to his attention. We feel compelled, therefore, to the conclusion, that

the 1st and 5th claims of the patent in suit are invalid for want of patentable novelty.”

In a more recent Ninth Circuit case, *Metler v. Peabody Engineering Corp.*, 77 F. (2d) 56, 58 the rule controlling here is given as follows:

“The presumption of validity which attends the issuance of letters patent by the Patent Office is overcome in this case by the clear evidence of anticipation in the prior art which was not cited or considered by the Patent Office when the application for appellant’s patent was passed on.”

Also to the same effect are the following:

France Mfg. Co. v. Jefferson Electric Co., 6 C.C.A. 106 F. (2d) 605:

“The usual presumption of validity arising from the granting of the patent in suit is weakened when the Patent Office did not have its attention directed to the most pertinent art.”

Sieberling Rubber Co. v. I. T. S. Co., 6 C.C.A. 134 F. (2d) 871, 873:

“When the validity of a patent is challenged it becomes the duty of the Court to ascertain just what it was that the patentee did that was not done before, and whether it denoted invention or whether it was within the expected routine skill of those laboring in the art.”

McClintock v. Gleason et al., 9th C.C.A. 94 F. (2d) 115, 116:

“The strong presumption of validity arising from the granting of a patent is weakened when it ap-

pears that the patent is granted without reference to pertinent art."

O'Leary v. Liggett Drug Co., 150 F. (2d) 656:

"The issuance of a patent creates no presumption of validity sufficient to overcome a pertinent prior art reference which has not been considered in the Patent Office."

Conclusions of law 2 and 3 are therefore in error.

THE PATENT IN SUIT IS INVALID.

The patent in suit is invalid for three reasons:

(a) Because the prior art fully anticipates the purported Granat invention;

(b) Because the patent claims are fatally defective in that they define an exhausted and old combination consisting of two connected finger rings together with a certain kind of connecting means, namely a dovetail tongue and groove or mortise and tenon connection, the invention if any residing in the connecting means per se; and

(c) Because the combination of the patent in suit does not constitute invention.

**(a) THE PATENT IN SUIT IS ANTICIPATED BY
THE PRIOR ART.**

It is quite obvious that the prior art, and particularly Kaas, Bullard, Thomas, Beaujard and Harris,

anticipate the combination of two finger rings held together in interlocked relationship. Taking the old *Thomas patent* for example, it is to be noted that two finger rings 12 and 14 are detachably held in interlocked relationship by means consisting of a key or projection 16 on the side of one ring extending through a key hole or recess in the side of the other ring. To employ the well-known and commonly used dovetail tongue and groove or mortise and tenon connection disclosed in Kelly, Atkinson, Tschirgi, Hubbard, Grierson, Birnbaum, Mittleburg and Linderman, to connect the rings 12 and 14 of Thomas together would certainly not amount to invention.

In the *Kaas patent* substantially the same type of connecting means as that used by Granat, is employed to hold the two rings B and C in interlocked relationship. It will be noted that the ring B is provided with a crown having a slotted side opening F which is adapted to receive the crown portion G of the ring C. This structure is practically identical in operation and construction to the Granat ring ensemble. The only difference is that the mortise on the side of Granat's engagement ring is adapted to receive a lug carried by the wedding ring, while in Kaas the mortise F on the ring B is adapted to receive the crown portion of the ring C. Such a slight change in the shape of the Kaas device obviously does not amount to invention.

In the *Bullard patent* we see another adaptation of the mortise and tenon type of connecting means. There the ring O is provided with a recess O' in its

crown while the other ring of the ensemble is formed with a lug or tenon 1 which projects into the recess O' to secure the two rings in interlocked relationship. It is interesting to note that the definition given in claim 3 of this patent reads directly on the Granat ring ensemble.

The locked ring ensembles of the prior art with the exception of Beaujard are provided with connecting means which prevents the relative independent rotation of either ring as well as their detachment one from another when worn on a finger.

In analyzing the claims of the patent in suit it is apparent that claims 1, 2 and 4 are substantially the same in that they each define a combination of two rings together with a connecting means of the mortise and tenon or dovetail tongue and groove type. It is to be noted that the expressions "mortise and tenon", and "dovetail tongue and groove" are considered here as synonymous terms, used interchangeably. For instance in the Atkinson patent, page 2, lines 1-23, this type of connection is referred to as being "dove-tailed" and is described in the manner of claims 1 and 2 of the patent in suit as comprising an "undercut flange" and an "undercut cavity". In Grierson, lines 50-55, the connection is referred to as comprising a "dovetail slot" and a "dovetail lug". In Hubbard the connection is described "dovetail groove" and "dove-tail rib." In Kelly and Linderman the connection is referred to as comprising a "dovetail tongue" and a "dovetail groove." In Tschirgi the connection is described as consisting of a "tenon and mortise", as

defined by Claim 4 of the patent in suit. Bullard also refers to his connecting means as comprising a "tenon" and a "recess". It therefore is to be noted that the expressions in the claims of the patent in suit describing the means connecting the two rings of the ensemble are identical in meaning.

Claim 3 of the patent in suit includes the same type of connecting means but it also has an element not found in the other three claims, namely a "stop for the lug". This stop is intended to prevent the removal of the lug from the recess only when one ring is shifted in a direction of the axes of the rings. A "stop" is commonly used to prevent one element from moving beyond a certain point with respect to another element of a combination. It certainly is not inventive to provide a stop on one ring to prevent movement of the other ring except in a certain direction. In the prior art this expedient is shown in Atkinson at B' ', in Grierson at B3, and also in Bullard in Kaas at points where one ring abuts the shank or flange of the other.

Upon reading the following decisions which are in point here it will be appreciated that the Granat ring ensemble is absolutely devoid of invention, and that whatever slight change was made in the prior art teachings was but a minor adaptation such as that to be expected by one skilled in the art. Using the well-known dovetail tongue and groove connection to hold two rings in interlocked relationship is not inventive under the controlling authorities.

The fairly recent Supreme Court case of *Cuno Engineering Corp. v. Automatic Devices Corp.*, 314 U. S. 84; 86 L. Ed. 58, is now widely recognized as a leading authority on the question of invention. The Mead patent there involved in the controversy concerned an automobile lighter embodying a cordless heating element having a thermostat for discontinuing the flow of electrical energy to the said element when the latter had reached a certain temperature. Prior to the Mead invention heating elements were commonly used and so were thermostats, but the application of a thermostat to a cordless heating element was not known before Mead's invention. However, the Supreme Court in conceding that the functions performed by Mead's combination were new and useful, ruled that they did not constitute invention or discovery. The court stated (pages 90-92 of 314 U. S.):

“We may concede that the functions performed by Mead's combination were new and useful. But that does not necessarily make the device patentable. Under the statute 35 U.S.C. sect. 31, R.S. 4886, the device must not only be ‘new and useful’, it must be ‘invention’ or ‘discovery’. *Thompson v. Boisselier*, 114 U.S. 1; 29 L. Ed. 76. Since *Hotchkiss v. Greenwood*, 11 How. 248, 267; 13 L. Ed. 683, decided in 1851 it has been recognized that if an improvement is to obtain the privileged position of a patent more ingenuity must be involved than the work of a mechanic skilled in the art. *Hicks v. Kelsey*, 18 Wall. 670; 21 L. Ed. 852; *Slawson v. Grand Street R. Co.*, 107 U. S. 649; *Saranac Automatic Machine Corp. v. Wirebounds Patents Co.*, 282 U. S. 704; 75 L.

Ed. 643; *Honolulu Oil Corp. v. Halliburton*, 306 U. S. 550; 83 L. Ed. 980. The principle of the *Hotchkiss* case applies to the adaptation or combination of old or well known devices for new uses. *Phillips v. Detroit*, 111 U. S. 604, 28 L. Ed. 532; *Concrete Appliances Co. v. Gomery*, 269 U. S. 177; 70 L. Ed. 222; *Powers-Kennedy Contracting Corp. v. Concrete Mixing & Conveying Co.*, 282 U. S. 175; 75 L. Ed. 278; *Electric Cable Joint Co. v. Brooklyn Edison Co.*, 292 U. S. 69; 78 L. Ed. 1131; *Altoon Publix Theatres Inc. v. American Tri-Ergon Corp.*, 294 U. S. 477, 79 L. Ed. 1005; *Textile Machine Works v. Hirsch Textile Machines Inc.*, 302 U. S. 490; 82 L. Ed. 382; *Toledo Pressed Steel Co. v. Standard Parts Inc.*, 307 U. S. 350; 83 L. Ed. 1334. That is to say the new device, however useful it may be, must reveal the flash of creative genius, not merely the skill of the calling. If it fails, it has not established its right to a private grant on the public domain.

“Tested by that principle Mead’s device was not patentable. We cannot conclude that his skill in making this contribution reached the level of inventive genius which the Constitution, Art. I, Sec. 8, authorizes Congress to reward. He merely incorporated the well known thermostat into an old wireless lighter to produce a more efficient, useful and convenient article. A new application of an old device may not be patented. The result claimed as new is the same in character as the original result. *Blake v. San Francisco*, 113 U. S. 679, 683; 28 L. Ed. 1070, even though the new result had not been contemplated. *Pennsylvania R. Co. v. Locomotive Engine Safety Truck Co.*, 110 U. S. 490, 494; 28 L. Ed. 222 and cases cited.

Certainly the use of a thermostat to break a circuit in a 'wireless' cigar lighter is analogous to or the same in character as the use of such a device in electric heaters, toasters, irons whatever might be the difference in detail of design. Ingenuity was required to effect the adaptation, but no more than that to be expected of a mechanic skilled in the art."

In *Blake v. City and County of San Francisco*, 113 U. S. 679, 28 L. Ed. 1070 it was held that it was not inventive to apply a relief valve to a steam fire engine when such a relief valve had been previously used on steam ships. The court stated at page 683:

"The application of a valve to a similar use on land was not a new combination or a new invention."

In *Pennsylvania R. Co. v. Locomotive Truck Co.*, 110 U. S. 490, 499; 28 L. Ed. 222, 225, the court said:

"The mere application of an old contrivance in an old way to an analogous purpose without novelty to the mode of applying such old contrivance in the new purpose is not a valid subject matter of a patent."

In *Paramount Pictures Corporation v. American Tri-Ergon Corporation*, 294 U. S. 463, 473; 79 L. Ed. 997, 1002, the court stated:

"The application of an old process to a new and closely analogous subject, plainly indicated by the prior art as an appropriate subject of the process is not invention."

In *Dreyfus v. Searle*, 124 U. S. 60, 64, the rule is stated as follows:

“There is no patentable invention in applying to the heating of wine or any other liquid, from the inside of the cask, the apparatus which had been previously used to heat another liquid in the same manner.”

In *Concrete Appliances Co. v. Gomery*, 269 U. S. 175, 185; 70 L. Ed. 222, 226, one of the leading cases on this subject, the rule is given as follows:

“The adaptation of * * * familiar Appliances to the movement and distribution of wet concrete * * * are persuasive evidence that this use in combination with well known mechanical elements was the product only of ordinary mechanical skill and not of inventive genius.”

In the more recent and particularly pertinent case of *Dow Chemical Co. v. Halliburton Co.*, 324 U. S. 319, 328; 89 L. Ed. 973, 980, the court said:

“He who is merely the first to utilize the existing fund of public knowledge for new and obvious purposes must be satisfied with whatever fame, personal satisfaction or commercial success he may be able to achieve. Patent monopolies, with all their significant economic and social monopolies, are not reserved for those who contribute so insubstantially to that fund of public knowledge.”

In the case of *Textile Machine Works v. Hirsch T. Machines*, 302 U. S. 489, 497; 82 L. Ed. 382, 387, the court stated:

“The addition of a new and useful element to an old combination may be patentable, but the addition must be the result of invention rather than the mere exercise of the skill of the calling and not one indicated by the prior art.”

The old case of *Hotchkiss v. Greenwood*, 11 How. 248; 13 L. Ed. 683, decided in 1851, is frequently referred to at the present time in patent suits, and in connection with the case at bar it is directly in point. There the invention covered by the patent in suit concerned the making of a door knob of clay and attaching it to a metal shank by a dovetail connection. The clay knob and the shank to which it was connected were both well known in the art, but the patentee contended that in combination with the peculiar type of connecting means the shank and knob involved patentable novelty. In declaring the patent invalid the court stated:

“But in the case before us the knob is not new, nor the metallic shank and spindle, nor the dovetail form of the cavity in the knob, nor the means by which the metallic shank is fastened therein. All these were well known and in common use. * * * Unless more ingenuity and skill in applying the old method of fastening the shank and the knob were required in the application of it to the clay or porcelain than were possessed by an ordinary mechanic acquainted with the business, there was an absence of that degree of skill and ingenuity which constitute essential elements, of every invention. In other words the improvement is the work of the skillful mechanic, not that of the inventor.”

In *Koochook Co. v. Barrett*, 158 F. (2d) 463, 466, 467 (8th C.C.A.), the court stated:

“We think that Barrett’s contribution cannot be held to constitute invention in the light of *Cuno Engineering Corp. v. Automatic Devices Corp.*, 314 U. S. 84, * * * the substitution by Barrett of a rotary type disc grinder for a cylindrical grinder or a grinder of the cone or rasp type used in tools similar to Barrett’s did not rise to the dignity of invention, and it is to be attributed to the mechanical skill of one versed in the art. Surely a skilled mechanic ordinarily should be capable of selecting from an assortment of abrasive tools of his trade the one best fitted to do the work at hand.”

In *Hannah M. Smith v. Springdale Amusement Park*, 283 U. S. 121, 123, 75 L. Ed. 878, 879, Justice Hughes stated the rule applicable here as follows:

“We agree with the Circuit Court of Appeals that the particular sort of spring support and the wire mesh partitions partially covered with fabric, as well as the other elements, are but forms of construction within the range of ordinary mechanical skill. There was an utter absence of invention justifying the issuance of this patent.”

In *Miller v. Foree*, 116 U. S. 22, 29 L. Ed. 552, 553, the patent in suit concerned the manufacture of plug tobacco with letters impressed therein. The prior art showed it old to make impressions in soap cakes, sealing wax, chocolate bars and butter. The court said, in holding the patent in suit invalid:

“The application of an old process or machine to a similar or analogous subject with no change in the manner of applying it and no result substantially distinct in its nature, will not sustain a patent, even if the new form or result has not been contemplated.”

In *McIvor v. Chemurgic Corporation*, 104 F. (2d) 58, (9th C.C.A.), this Court, in holding the patent in suit invalid, stated:

“The addition of a new and useful element to an old combination may be patentable; but the addition must be the result of invention rather than the mere exercise of the skill of the calling, and one not plainly indicated by the prior art.”

THE DOVETAIL TONGUE AND GROOVE CONNECTION BEING A COMMONLY USED EXPEDIENT CANNOT GIVE PATENTABLE NOVELTY TO GRANAT'S RING ENSEMBLE.

The prior art showing the use of dovetail tongue and groove connections for joining two members together is quite extensive. In fact this well known expedient is commonly used in various arts, as shown by the several representative patents in evidence here. The testimony of plaintiffs' expert witness (R. pp. 78, 79) further shows this type of connection to be commonly used by artisans in many arts. The authorities, herein-after listed, clearly indicate that a commonly known expedient when transplanted from one art to another does not make an old combination patentable, even though it had not been previously used in the particular art to which it has been transferred. In the case

at bar, the patentee Granat, merely adopted the well known dovetail tongue and groove connecting means found extensively in the prior art, as a means for detachably securing two finger rings together. The combination of the two finger rings joined together is not patentable since Thomas, Kaas, Bullard and other prior patents clearly show this arrangement to be old. Neither is the dovetail tongue and groove or mortise and tenon type of connecting means new, since such patents as Kelly, Tschirgi, Hubbard, Mittleburg, Grierson, Atkinson and Linderman clearly indicate that this is an old and commonly used expedient in the connecting of two elements together. These latter patents are pertinent here in view of the principles set forth in the following decisions.

The U. S. Supreme Court case of *Mast, Foos & Co. v. Stover Mfg. Co.*, 177 U. S. 485, 491, 44 L. Ed. 856, 859, is a leading case on this subject, and its doctrine has been followed in all of our courts including the Ninth Circuit Court of Appeals. In this case the Martin patent in suit related to an improvement in a windmill and the patentable novelty was alleged to have resided in an external toothed pinion in association with an internal toothed spur wheel. The prior art showed this combination to be old, well known and commonly used in various types of machinery including harvesters, churns, and sewing machines. The following quotation is quite lengthy because of its pertinency here:

“In the present case, however, not only are there a large number of patents shown containing this

combination (the pitman actuated by two eccentric external toothed gears) but several in which the combination is used for different purposes than in the construction of windmills * * *. The case then reduces itself to this: The Martin combination had previously been used in a large number of mechanical contrivances for the purpose of converting a rotary into a reciprocating motion. * * * Having all these devices before him (the patentee), he is chargeable with the knowledge of all pre-existing devices, did it involve an exercise of inventive faculty to apply this same combination to a windmill for the purpose of converting a rotary into a reciprocating motion? We are of the opinion that it did not. The main advantage derived from it arose from the engagement of a large number of teeth in each wheel. This peculiarity, however, inured to the advantage of every machine in which the combination was used for the purpose of converting motion * * * *Martin therefore discovered no new function, and he credited no new situation, except in the limited sense that he first applied an internal gearing to the old Mast-Foos mill which was practically identical with the Martin patent except in the use of internal gearing. He invented no new device. He used it for no new purpose. He applied it to no new machine. All he did was to adapt it to a new purpose in a machine where it had not been used for that purpose. The result may have added to the efficiency and popularity of the earlier device although to what extent is open to serious doubt. In our opinion this transfer does not arise to the dignity of invention."*

In *Peveley Dairy Co. v. Borden Printing Co.*, 123 F. (2d) 17, 19, Ninth Circuit Court of Appeals, this court stated the rule applicable here as follows:

“It is well settled that mere application of an old device to a new use does not constitute invention.”

In *John Bean Mfg. Co. v. Creagmile*, 123 F. (2d) 182, 185, Ninth Circuit Court of Appeals, this court in holding the patent in suit invalid followed the rule of the *Mast, Foos* case and stated:

“Mere application of a mechanical equivalent to another use is not invention.”

In *Vandenburg v. Truscon Steel Co.*, 261 U. S. 6, 15, 67 L. Ed. 506, 512, the patent in suit related to concrete reenforcing in which a kerf and an integral spur were used to clamp and hold a spiral rod. The kerf and spur were new in the concrete reenforcing art but were old in the metal working art. The Supreme Court in declaring the patent invalid stated:

“It is true that in the field of reenforcing concrete the kerf and spur had not been used before as Vandenburg used it, but the kerf and spur were old in the art of kindred fields. They were old in the metal working art. Exactly the equivalent is shown in sand screens for mixing the materials of concrete and in sustaining fence wires. * * * It does not seem to us that it involved real invention merely to add a spur or clamp, or to peen or hammer down the edges of the kerf to fix the spiral rod firmly. We find therefore the claims without merit as involving invention.”

Particularly in point here for the reasoning behind the rule, is the case of *Old Town Ribbon & Carbon Co. v. Columbia R. & C. Mfg. Co.*, 159 F. (2d) 379, 382. Judge L. Hand's opinion is as follows:

“The constitution (Art. I, Sect. 8) gives Congress power to grant unlimited monopolies for ‘discoveries’ and there is no antecedent reason for saying that Congress might not if it choose, issue a patent for a new use of an old physical object, which is in fact closely akin to, if not identical with an ‘art’, like a process. There would be nothing unreasonable in so doing; substantially no ‘machine’, ‘manufacture or composition of matter is ever new throughout’, usually it is a combination of elements, all of which are severally old, and the invention consists in the mental act of fabricating the combination. Nevertheless since 1793 unless a patent disclosed a new and useful art, a new ‘machine’, a new ‘manufacture’, or a new ‘composition of matter’ it has not been a valid patent. If it be merely for a new employment of some ‘machine, manufacture, or composition of matter’ already known, it makes not the slightest difference how beneficial to the public the new function may be, how long a search it may end, how many should have shared that search, or how high a reach of imaginative ingenuity the solution may have demanded. All the mental factors which determine invention may have been present to the highest degree, but it will not be patentable because it will not be within the terms of the statute. *This is the doctrine that a new ‘use’ can never be patentable.* In this circuit we have many times applied it and it has been recognized elsewhere.
* * * The act of selection out of which the new

structure arises, is the determinant, and small departures may signify and employ revolutionary changes in discovery; *but the law does not protect the act of selection per se, however meritorious, when it is not incorporated into some new physical object.*”

The same principle is followed in *Altoona v. American et al.*, 294 U. S. 477, 79 L. Ed. 483, wherein the court stated:

“The inclusion of a fly wheel in any form of mechanism to secure uniformity of its motion has so long been standard procedure in the field of mechanisms and machine design that the use of it in the manner claimed by the present patent involved no more than the skill of the calling. * * * The patentees brought together old elements, in a mechanism involving no new principle, to produce an old result, greater uniformity of motion. However skillfully this was done * * * it still was the product of skill not invention.”

In *Barry v. Studebaker Corp.*, 113 F. (2d) 400, 402, it was held that the use of commonly used flanging as means for connecting two elements together was not patentable. The court stated:

“The use of flanging in the art of metal working is old and there is no novelty in the use of flanges for the purpose of joining or combining complementary members to form hollow metal structures.”

The case of *Friend v. Burnham & Morrill Co.*, 55 F. (2d) 150, 151, is particularly in point here in that it holds that courts shall take into consideration *matters*

of common knowledge in determining whether a conception involves invention. The court stated the rule as follows:

“In determining whether a patent covers a process, the conception of which involves invention, the court is not required to shut its eyes to matters of common knowledge. (*King v. Gallum*, 109 U.S. 99, 27 L. Ed. 870.) The court may take into consideration common or general knowledge tending to show the devices or process described in the patent is old or lacking in invention, and the court may refresh and strengthen its recollection of what facts are of the common and general knowledge at the time of the application for patent by reference to any printed source of information which is known to the court to be reliable and published prior to the application for patent. (*American Fibre-Chamois Co. v. Buckskin-Fibre Co.*, 72 F. 508.)”

In *King v. King et al.*, 109 U.S. 99, 27 L. Ed. 870, 871, the rule is stated as follows:

“In deciding whether the patent covers an article the making of which requires invention, we are not required to shut our eyes to matters of common knowledge or things in common use.”

The recent United States Supreme Court case of *Mandel Bros. v. Wallace*, Vol. 93, No. 1, U. S. Supreme Court, Law Ed. Advance Opinions, page 11, decided November 8, 1948, follows the same line of reasoning first established in the *Mast-Foos* case. The patent in suit related to a cosmetic preparation for retarding perspiration. The prior art included many

similar preparations which were undesirable because of their skin irritating and cloth corroding qualities. The patentees discovered an ingredient called "urea" which was capable of overcoming these deficiencies, and as a result they prepared a new compound which they patented. The patented preparation met with tremendous commercial success throughout the country. (*Wallace v. Mandell Bros.*, 164 F. (2d) 861, 862.) The use of "urea" had not been previously used in antiperspirants, but it was a matter of public knowledge that it had previously been used as a corrosion inhibitor in other types of compounds. The Supreme Court in holding the patent invalid stated:

"All that these patentees did was to utilize in a cosmetic preparation, publically available knowledge that urea would inhibit acidic corrosion. *The step taken by the patentees in advance of past knowledge was too short to amount to invention. They merely applied an old process of inhibition to a new cosmetic use.* This is not invention."

In the Supreme Court case decided January 3, 1949, *Jungersen v. Ostby and Barton Company et al.*, reported in Vol. 619, Patent Office Gazette, at page 611, it was again held that invention was not involved in applying a technique old in other arts to a new use. In holding the Jungersen patent invalid for lack of invention the court said:

"The patentee contends, however, that jewelry casting is a separate and distinct art; that consequently the advancements in other types of casting mentioned above cannot be viewed as the prior art in reference to this patent. The answer to this is

two fold * * * we think that the improvements in the art of casting which were disclosed by the patents and publications discussed above were so obviously applicable to the type of casting to be effected by Jungersen that he was bound by the knowledge of them."

**(b) THE PATENT CLAIMS ARE INVALID BECAUSE THEY
DEFINE AN EXHAUSTED COMBINATION.**

The claims of the patent in suit set forth a structure consisting of two finger rings in combination with interlocking means of the dovetail tongue and groove type for holding them in connected relationship. The combination of two finger rings in combination with mechanical means for holding them in connected relationship, is not new in the art. The Kaas, Thomas, Harris and Bullard patents each show two finger rings held in interlocked relationship. The mechanical connecting means of each of these patents operates in the identical same manner as the dovetail tongue and groove connection of the patent in suit. They each hold the two rings in connected relationship and prevent their relative rotation. Obviously this combination is not the subject matter for further patenting. It is an exhausted combination. If there was any patentable novelty involved in the purported Granat invention it resided in the connecting means per se, rather than in a combination which included the two finger rings. None of the claims, however, define the dovetail tongue and groove connecting means per se.

The claims of the patent in suit are therefore fatally defective. Finding No. 5 is therefore clearly erroneous.

It is to be noted that the patentee Joseph Granat himself considered his invention to reside in the connecting means per se. Mr. Granat testified as follows (Granat deposition, page 9):

“Mr. Trabucco. Q. Do you consider your invention to reside in the interlocking means between the rings?

Mr. Mellin. Object to that on the ground that the patent speaks for itself.

A. Interlocks—you have all the information right there in the patent—it is all there.

Mr. Trabucco. Q. The question was is the invention set forth in the patent, does that consist in the means for holding the rings together in interlocked relationship?

A. Yes.”

A leading case on this subject is *Bassick Mfg. Co. v. Hollingshead Co.*, 298 U. S. 415, 80 L. Ed. 1251. There the subject matter of the Gullborg patent in suit was a device for lubricating the bearings of automobiles. The combination disclosed by the Gullborg patent in suit consisted of a grease pump, a hose or coupler, and a grease cup or pin fitting associated with the bearing to be lubricated. The elements were all old, but the inventor provided a new type of coupler for connecting the hose with the grease cup or fitting. In holding the patent invalid the court said at page 424 (L. Ed. 1256):

“It is plain that Gullborg invented improvements in two of the mechanical elements of an old combination consisting of a grease pump, hose, hose coupler and grease cup or pin fitting. * * * he claimed a combination of pump, hose coupler, and pin fitting, and embodied in the combination his improved form of coupler. * * * *The question then is whether the patentee, by improving one element of an old combination whose construction and operation are otherwise unchanged, may, in effect re-patent the old combination by reclaiming it with the improved element substituted for the old element. That this cannot be done is shown by numerous cases in this and other federal courts.*”

In the later case of *Lincoln Engineering Co. v. Stewart Warner Corp.*, 303 U. S. 545, 82 L. Ed. 1008, the same ruling was made with respect to a similar combination. There the Butler patent involved apparatus for lubricating bearings of automobiles, and it employed a nipple or fitting connected to the bearing to be lubricated, a gun or pump for propelling the grease under pressure, a hose or conduit for connecting the gun with the fitting, and coupling means for connecting the conduit to the fitting, and for making a tight joint during the greasing operation. It was old in the art to provide a fitting or nipple, a grease gun and a coupler, but it was contended that since the nipple operated in an improved and novel manner, unlike similar devices of the prior art, the claims defining the entire combination were valid. The court, however, disregarded this contention and held the patent in suit invalid, at page 550 (L. Ed. 1010), the court said:

“The improvement of one part of an old combination gives no right to claim that improvement in combination with other old parts which perform no new function in the combination. * * * The invention, if any, lies in the coupling device alone.”

In *Etter v. Kauffman*, 32 F. Supp. 186, 189 (sustained in 121 F. (2d) 137), the same doctrine was stated as follows:

“We cannot see that the whole wringer structure could be covered by a combination claim by the mere improvement of one element of an old combination.”

(Citing *Bassick v. Hollingshead and Lincoln v. Stewart-Warner Corp.*, supra.)

The same rule was applied in *Re: Application of Trier*, 163 F. (2d) 575, 578, as follows:

“Those claims call for the combination of an intermittently operated conveyor and a plurality of spraying devices designed to supply liquid to articles on the conveyor. This combination is clearly shown to be old in the Ladewig patent. Any novelty which those claims present over the disclosure in that patent therefore, resides in the spraying devices per se or in the specific conveyor structure and not in the association of a plurality of such devices with a conveyor. *The improvement of one element of an old combination does not justify a claim to the improved element together with old parts which perform no new function in the combination.*”

In *Krause v. Coc*, 120 F. (2d) 717, 718, the court said:

“The only new specific thing that Krause has done is to substitute, in a flush valve, a rubber or a graphite rubber packing for any other possible type; apparently leather has been the common packing material although previous patents have mentioned any suitable material. Why then should Krause make combination claims on this whole valve. He argues that his packing was such an improvement that it made all the parts of the valve work in a new and unexpected cooperation justifying the combination claims * * *. There may have been a new and unexpected result in that Krause’s device worked better than any previous valve or that it worked better than anticipated * * *. Krause may have a better packing that makes a better valve but there is no unexpected or different cooperation. To say that the Krause flush valve works better than any other one is not to say that something new has been invented. Patentable invention takes more imaginative association of old and new than that.”

In *Visher Products Co. v. National Pressure Cooker Co.*, 71 F. Supp. 973, 979, the District Court, in holding the contested claims invalid, stated as follows:

“A patentee cannot by improving one element of an old combination whose construction and operation is otherwise unchanged, in effect, repatent the old combination by reclaiming it with the improved element substituted for the old element. All Vischer did was to substitute the rubber blow-out plug, for the fusible blow-out plug, which is

not invention. *Any patented device all the elements of which are old and each of which performs the same function taught by the prior art, fails of invention.*" (Citing *Bassick v. Hollingshead*, supra.)

(c) THE COMBINATION OF THE PATENT IN SUIT DOES NOT CONSTITUTE INVENTION.

It is apparent that all of the elements of the Granat ring ensemble are old in the art. In each of the patents to Kaas, Bullard, Thomas and Harris is found two finger rings held in joined relationship by mechanical connecting means. In each of these patents the two rings of the ensemble when on a person's finger are secured against independent rotation and also against detachment by the same mechanical connecting means which holds them in joined relationship. In the patent in suit the dovetail tongue and groove connecting means functions in precisely the same manner as the mechanical connecting means of the prior art. (R. p. 77.) Granat's connecting means performs no new function. It merely holds the two rings of the ensemble when worn on a person's finger against relative rotation and against detachment. In so far as the connecting means per se is concerned it embodies the same elements and functions in the exact manner as the dovetail tongue and groove or mortise and tenon connecting means disclosed in Atkinson, Grierson, and the various other representative patents listed herein. All of such connecting means, including that of the

patent in suit operate to hold two elements in connected relationship.

It is well established in patent law that the assembly of a number of well known elements which function in a well known manner without performing new and unexpected results, does not amount to invention. Such an assembly is an "aggregation", not a "patentable combination".

In *Richards v. Chase Elevator Co.*, 158 U. S. 299, 302, 39 L. Ed. 991, 993, the rule applicable here is stated as follows:

"So long as each element performs some old and well known function, the result is not a patentable combination, but an aggregation of elements."

In *Grinnell Washing Machine Co. v. Johnson Co.*, 247 U.S. 425, 433, 62 L. Ed. 1196, 1200, the court said:

"Applying the rule thus authoritatively settled by this court, we think no invention is shown in assembling these old elements for the purpose declared. *No new function is 'evolved from this combination; the new result, as far as one is achieved, is only that which arises from the well known operation of each one of the elements.'*"

In *Powers-Kennedy Contracting Corporation v. Concrete Mixing and Conveying Company*, 282 U.S. 174, 186, 75 L. Ed. 278, 286, it is said:

"Neither the combination of old elements or devices accomplishing no more than an aggre-

gate of old results, nor the use of an old apparatus or appliance for a new purpose is invention.”

In *Elliott Core Drilling Co. v. Smith*, 50 F. (2d) 813, 816, 9th CCA, this court stated the rule applicable here as follows:

“A mere carrying forward of the original thought, a change only in form, proportions or degree, doing the same thing in the same way, by substantially the same means, with better results, is not such invention as will sustain a patent.”

The same rule is restated in *Willamette-Hyster Co. v. Pacific Car & Foundry Co.*, 9th CCA, 122 F. (2d) 492, 501.

In *Blanc v. Spartan Tool Co.*, 168 F. (2d) 296, 299, 7th CCA, the court said:

“Bringing together of old devices, without securing some new and useful result as the joint product of the combination, does not constitute a patentable invention, 141 U.S. 539; 35 L. Ed. 879, and when no new function results from a combination of elements and the new result is merely that which arises from the operation of each one of the elements, the arrangement does not constitute invention. There is merely an ‘aggregate of old results.’ ”

In *Dallas Machine & Locomotive Works, Inc. v. Willamette-Hyster Co., et al*, 112 F. (2d) 623, 626, 9th CCA, this court in holding the patent in suit

invalid because it covered an unpatentable aggregation, stated the rule as follows:

“* * * mere aggregation of a number of old parts or elements which in the aggregation, perform or produce no new result or different function or operation than that theretofore performed or produced by them is not patentable invention.” (Citing *Lincoln Engineering Co. v. Stewart Warner Corp.*, 303 U.S. 545, 549; 82 L. Ed. 1008; *Hailes v. Van Wormer*, 87 U.S. 353, 368; 22 L. Ed. 241.)

In *Wilson-Western Sporting Goods Co. v. Barnhart*, 81 F. (2d) 108, 110, 9th CCA, this court held the patent in suit covering a golf club invalid. One of the references relied on to show anticipation was a Robertson patent showing a fishing rod. In the court's opinion it was stated:

“It may be objected that Robertson's patent did not deal with golf clubs. It is well established, however, that ‘the application by the patentee of an old process to a new subject, without any exercise of the inventive faculty, and without the development of any idea which can be deemed new or original in the sense of the patent law’ is fatal to the patent.

“A mere carrying forward or a more extended application of the original thought, a change only in form, proportions or degree, the substitution of equivalents, doing substantially the same thing in the same way by substantially the same means with better results, is not such invention as will sustain a patent.” (Citing *Smith v. Nichols*, 21 Wall. (88 U.S.) 112, 119; 22 L. Ed. 566.)

In *Eagle, et al. v. P. & C. Hand Forged Tool Co.*, 74 F. (2d) 918, 920, 9th CCA, the patent in suit relating to a wrench handle, was held by this court to be invalid. In view of the similarity between the subject matter of the present suit and that of the reported case, the rule stated by this court at page 920 is particularly applicable here:

“It is not necessary that all of the elements of the claim be found in one prior patent. If they are all found in different prior patents and no functional relationship arises from the combination, the claim cannot be sustained. *Keene v. New Idea Spreader Co.*, 231 F. 701.

“All the elements of the patent in suit were present in the prior art, and combining these elements to make the patented device did not involve invention. Widespread use of the device combining these elements old in the art is evidence of its utility, but is not conclusive of its patentable novelty.”

The court's opinion in *Dailey v. Lipman, Wolfe & Co.*, 88 F. (2d) 362, 9th CCA, is particularly in point here in that it holds no invention is involved in a combination wherein a device thereof is the equivalent of and performs the same function as a similar device found in the prior art. In the case at bar the dovetail tongue and groove connecting means of the patent in suit, being a device for holding two elements in interconnected relationship, is the full equivalent of the devices used for the same purpose

as found in Thomas, Atkinson and the various other prior art patents.

Findings 13 and 16 in view of the foregoing are obviously in error.

COMMERCIAL SUCCESS HAS NO WEIGHT HERE.

Appellees contend that the commercial success of their patented ring ensemble indicates patentable novelty. The testimony of Mr. Wineroth a witness for appellees indicates that several types of interlocking rings have been and now are being sold by appellee Granat Bros. (R. pp. 110, 119). In describing the first ring ensemble manufactured and sold by said appellees the witness described the combination disclosed in the Granat patent No. 1,982,864. (R. p. 113). It is therefore to be assumed that at least some of the so-called commercial success claimed by appellees is attributable to ring ensembles having locking means other than the dovetail tongue and groove type of the patent in suit.

Irrespective of whether the patented ring ensembles sold by appellees met with commercial success, evidence on this point does not carry any weight since it is most apparent that the purported Granat invention does not possess patentable novelty. Only when patentable novelty is in doubt can commercial success have any weight in sustaining a patent.

There are many cases on this subject including *McClain v. Ortmyer*, 141 U.S. 419, 35 L. Ed. 800;

Lovell Mfg. Co. v. Cary, 147 U.S. 623, 37 L. Ed. 307; *Duer v. Corbin Cabinet Lock Co.*, 149 U.S. 216, 37 L. Ed. 707, etc.

In the recent *United States Supreme Court Case of Dow Chemical Co. v. Halliburton Co.*, 324 U.S. 319, 331, 89 L. Ed. 973, 981, the court said:

“Petitioner claims the Grele-Sanford process has filled a long felt want and has been a commercial success. But these considerations are relevant only where all other proof leaves the question of invention in doubt.”

In *Florence Mayo Nuway Co. v. Hardy*, 168 F. (2d) 778 at page 787, the court said:

“I think the Judgment of the District Court should be affirmed. It takes something more than commercial success of a device and the imitation of one's product by a competitor to establish the validity of a patent.”

The Circuit Court of Appeals for the Second Circuit has recently further discredited the “commercial success” influence on the patentability of inventions by referring to the trend of recent United States Supreme Court decisions on this subject. The case of *Jungerson v. Baden*, 166 F. (2d) 807, 811, states as follows:

“In the past the commercial success enjoyed by plaintiff might well have sufficed to tip the balance in favor of validity. *Recent Supreme Court pronouncements indicate clearly that commercial*

success cannot raise a combination of known elements to the exalted level of invention."

Citing *Sinclair & Carroll Co. v. Interchemical Corp.*, 325 U.S. 327, 89 L. Ed. 1644; *Funk Bros. Seed Co. v. Kalo Inoculent Co.*, 68 S. Ct. 444, 92 L. Ed. 414.

In the very recent *Supreme Court Case of Jungerson v. Ostby and Barton Company, et al.*, decided January 3, 1949, reported in Vol. 619, Patent Office Gazette, p. 611, the court again repeated the rule with respect to commercial success as follows:

"The fact that this process has enjoyed considerable commercial success, however, does not render the patent valid. It is true that in cases where the question of patentable invention is a close one, such success has weight in tipping the scales of judgment toward patentability. Where, as here, however invention is plainly lacking, commercial success cannot fill the void. Increased popular demand for jewelry or alertness in exploitation may have played an important part in the wide use of the patent. We cannot attribute Jungerson's success solely or even largely to the novelty of his process. We hold the patent invalid for want of invention."

Goodman v. Paul E. Hawkinson Co., 120 F. (2d) 167, 173 Ninth Circuit Court of Appeals, is an authority supporting appellants' contention with respect to the question of commercial success. There it was held that there is an element of unfairness in a contention that commercial success is to be attributed

to certain claimed structures where there were various similar structures being sold.

In *McGhee et al. v. La Sage & Co. Inc.*, 32 F. (2d) 875, Ninth Circuit Court of Appeals, this court held that commercial success does not necessarily indicate novelty.

CONCLUSION.

Summarizing the foregoing it will be noted that in the present case the presumption of validity sometimes attending the issuance of a patent is negatived by the failure of the Patent Office examiner to cite pertinent prior art during the prosecution of the patent application which resulted in the issuance of the patent in suit. The patent in suit is invalid for the reason that the purported invention claimed therein is fully anticipated by the prior art. The mere substitution of one well known and commonly used type of connecting means (dovetail tongue and groove connection) for another type in an interlocking ring ensemble, is not inventive nor does it amount to patentable novelty. The claims of the patent in suit are each fatally defective and invalid in that they set forth an old and exhausted combination. The Granat ring ensemble does not amount to invention since it is merely an assemblage of old and well known devices.

It is therefore submitted that plaintiffs' complaint for a declaratory judgment decreeing the patent in

suit to be invalid should be sustained and that appellees' cross-complaint alleging infringement should be dismissed. The judgment of the lower court should be reversed.

Dated, San Francisco, California,

March 18, 1949.

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Attorney for Appellants.